REMARKS/ARGUMENTS

Restriction Requirement

The Office Action has set forth a restriction requirement. Applicants elect, with traverse, the claims of Group III (i.e., claims 1, 3, 4, 6-12, and 15). Reconsideration of the requirement for restriction is respectfully requested for the reasons discussed below.

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (M.P.E.P. § 803).

The Office Action alleges that the inventions defined by the claims of Groups I-VII are distinct because the species of each group have different modes of operation. More specifically, the inventions allegedly are distinct because they are directed to treating diseases with distinct etiologies and symptoms. Because the inventions are distinct, there allegedly would be a serious burden on the Examiner if restriction was not required. Applicants respectfully disagree. The fact that a search for one group of claims may not overlap with the search for another group of claims does not necessarily mean that conducting such searches concurrently would place a "serious burden" on the Examiner. Indeed, since the claims of Group III relate to a method of using a compound of formula (I), and the claims of Groups I, II, and IV-VII also relate to methods of using the compound of formula (I), it would appear that there would be no "serious burden" on the Examiner to address the claims of Groups I-VII at one time.

Moreover, even though the various indications recited in independent claims 1 and 6 have different symptoms, they are linked by a common mechanism. In particular, the specification points out that urinary acidification, bone resorption, osteoporosis, fertility, angiogenesis, glaucoma, and Alzheimer's disease are all treatable by compounds that inhibit

vacuolar-type (H+)-ATPase. Therefore, where it may seem that the various indications are distinct, they share a common linking concept in their treatment with the compound of formula (I) and the mechanism of action of that compound.

Moreover, Applicants respectfully point out that the various conditions have already been searched by the Examiner. The language of claims 1 and 6 originally read "a method of treating a condition treatable by the inhibition of vacuolar-type (H+)-ATPase." Original claims 13-17 are directed to specific indications treatable by the inhibition of vacuolar-type (H+)-ATPase, such as urinary acidification, bone resorption, osteoporosis, fertility, and angiogenesis. Thus, it appears that the Office did not consider it to be a serious burden to search the various named indications before.

Accordingly, there would appear to be sufficient similarity between the claims of Groups I-VII to allow for the search and examination of the subject matter of all the pending claims at the same time without a "serious burden" being placed on the Examiner. Applicants, therefore, request withdrawal of the restriction requirement, and respectfully submit that the claims of Groups I-VII should be examined together.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,

Kristen J. Harrell

Kristen J. Harrell, Ph.D., Reg. No. 51,783
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: January 16, 2007